

AMENDMENT UNDER 37 C.F.R. § 1.111

Application No.: 10/781,906

Atty Docket No.: Q80049

REMARKS

The Office Action of May 3, 2005 has been received and its contents carefully considered.

Claims 1 to 4 are all the claims pending in the application.

The Examiner points out that the parent application Serial No. 10/082,201 has now issued as U.S. Patent No. 6,699,600. The Examiner requests applicants to update the status of the parent application.

In response, applicants have amended the present application to update the status of the parent application to indicate that it is now U.S. Patent 6,699,600.

Claims 1-4 have been rejected under the second paragraph of 35 U.S.C. § 112 as indefinite.

The Examiner sets forth two reasons for this rejection. Applicants discuss each reason below.

The Examiner states that the word "type" in the terms "CoPtX type alloy" and "CoCrPtX type alloy" in claims 1 and 2 are indefinite.

In response, applicants have amended claims 1 and 2 to delete the term "type" from these claims.

The Examiner states that the term "a large number" in claims 1 and 2 is indefinite.

In response, applicants have amended claims 1 and 2 by deleting the term "a large number".

AMENDMENT UNDER 37 C.F.R. § 1.111

Application No.: 10/781,906

Atty Docket No.: Q80049

In view of the above, applicants submit that the claims comply with the requirements of the second paragraph of 35 U.S.C. § 112 and accordingly, request withdrawal of this rejection.

Claims 1-4 have been rejected under the first paragraph of 35 U.S.C. § 112 as being based on a non-enabling disclosure.

The Examiner states that he does not understand how a composition CoPtX or CoCrPtX, where X is at least one of SiO₂, SiO, Si₃N₄, Al₂O₃, AlN, TiO, TiO₂, TiN, BN, CaF₂ and TiC can be said to be an "alloy". In particular, the Examiner states that he does not understand how the SiO₂, SiO, Si₃N₄, Al₂O₃, AlN, TiO, TiO₂, TiN, BN, CaF₂ and TiC components can be considered to qualify as an alloy.

The Examiner does not explain why he does not understand how these components can be considered to qualify as an alloy. Applicants assume that the Examiner understands the term "alloy" to mean a solid or liquid mixture of two or more metals. The compositions employed in the present invention contain a component X which is not a metal. The Examiner, therefore, apparently questions how these compositions can be called alloys.

In response, applicants point out that the term "alloy" is not limited to a solid or liquid mixture of two or more metals, but has a broader meaning. See, for example, the definition of "alloy" in Webster's New World Dictionary, Second College Edition, 1980, page 38, a copy of which is attached, which defines an "alloy" as "a substance that is a mixture, as by fusion, of two or more metals, or of a metal and something else". Similar definitions can be found in other

AMENDMENT UNDER 37 C.F.R. § 1.111

Application No.: 10/781,906

Atty Docket No.: Q80049

dictionaries. See, for example, the definitions of alloy in WordWebOnline.com dictionary and Dictionary.com, copies of which are attached, as printed from their websites.

The present specification clearly indicates at pages 20 and 21 (Test Examples 53 to 69), page 27 (Table 6) and page 28 that the present invention employs an alloy composition which includes as a component one of the named SiO_2 , SiO , Si_3N_4 , Al_2O_3 , AlN , TiO , TiO_2 , TiN , BN , CaF_2 and TiC components. See especially the last paragraph on page 28 which refers to the CoPtX and CoCrPtX compositions of Table 6 as being alloys.

Accordingly, applicants submit that the specification clearly shows that the compositions set forth in the present claims are considered to be alloys.

In view of the above, applicants submit that the claims comply with the requirements of the first paragraph of 35 U.S.C. § 112 and, accordingly, request withdrawal of this rejection.

Claims 1-4 have been rejected under the second paragraph of 35 U.S.C. § 112 as failing to set forth the subject matter which applicants regard as their invention.

In this rejection, the Examiner refers to various portions of the present specification where X is stated to be one or more of Mo, B, V, W, Zr, Re, Cu, Ru, Hf, Ir and Y.

In addition, the Examiner refers to the disclosure at page 9, seventh paragraph, where it is stated that the SiO_2 , SiO , Si_3N_4 , Al_2O_3 , AlN , TiO , TiO_2 , TiN , BN , CaF_2 and TiC components are magnetic grain separating materials and are not an alloy or compound.

The Examiner states that the present invention as described in the specification is unlike what has been set forth in the claims.

AMENDMENT UNDER 37 C.F.R. § 1.111

Application No.: 10/781,906

Atty Docket No.: Q80049

In response, applicants submit that the Examiner has overlooked the disclosure in Test Examples 53 to 69 described at pages 20 and 21, the disclosure in Table 6 at page 27, and the discussion of Table 6 in the last paragraph of page 28 of the specification.

Applicants submit that the disclosure of Test Examples 53-69 at pages 20 and 21, Table 6 at page 27, and the disclosure at page 28, last paragraph, establish that what has been described in the claims has also been described in the specification.

In view of the above, applicants request withdrawal of this rejection.

The Examiner provides comments on the Examples in the specification by stating that the examples and showings such as those illustrated in Fig. 3 of the present specification have been considered, but that these examples do not bear on what has been claimed. The Examiner states that the examples and showings in the present specification are all concerned with compositions where X is a variety of metals, and do not reflect any of the claimed subject matter where X is any one of SiO₂, SiO, Si₃N₄, Al₂O₃, AlN, TiO, TiO₂, TiN, BN, CaF₂ and TiC.

Again, applicants submit that the Examiner has overlooked the disclosure of Test Examples 53 to 69 at pages 20 and 21, Table 6 at page 27 and the disclosure in the last paragraph of page 28 of the specification.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111

Application No.: 10/781,906

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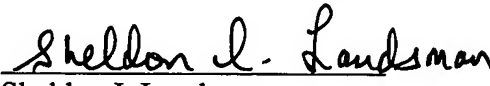
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